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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/301,989 04/29/99 LAOR

H 4261500150

KENT A FISCHMANN
HOLME ROBERTS & OWENS
1700 LINCOLN STREET
SUITE 4100
DENVER CO 80203

PM82/0406

EXAMINER

MUN, K

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 04/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/301,989

Applicant(s)

LAOR, HERZEL

Examiner

K. Kevin Mun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 48-58, drawn to a method, classified in class 376, subclass 146.
 - II. Claims 17-47, drawn to an apparatus, classified in class 376, subclass 102.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus of Invention II does not have to be operated in the manner illustrated by the method steps of Invention I. For example, the apparatus of Invention II is inherently capable of being used to practice a materially different process, such as making ice.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Upon election of one the inventions identified above as I and II, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- a. forming Bose-Einstein condensate by providing a multiplicity of bosons
- b. forming Bose-Einstein condensate by providing a multiplicity of Fermions

Currently, Claims 1 and 2 are generic.

Upon election of one the inventions identified above as I and II, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- f. a beam for applying a compressive force is an electron beam
- g. a beam for applying a compressive force is a particle beam

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- h. a beam for applying a compressive force is a beam of material
- i. a beam for applying a compressive force is a radio frequency energy
- j. a beam for applying a compressive force is a high energy laser beam
- k. a beam for applying a compressive force is a x-ray beam
- l. a beam for applying a compressive force is light

Currently, Claim 1 is generic.

If Invention I is elected, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- I.a means for using the reaction product steam is for propulsion
- I.b means for using the reaction product steam is for running a power generator
- I.c means for using the reaction product steam is to mix with supplemental material

Currently, Claims 48, 53 and 55 are generic.

If Invention II is elected, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- II.a the focusing means for a beam is lens
- II.b the focusing means for a beam is mirror
- II.c the focusing means for a beam is electromagnetic means

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Currently, Claims 17, 24, and 35 are generic.

If Invention II is elected and upon election of one of the species identified above as II.a and II.b, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

II.f a window into the reaction chamber formed from sapphire

II.g a window into the reaction chamber formed from diamond

Currently, Claim 17 is generic.

If Invention II is elected, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

II.o converting means is a means to transform the generated heat into energy
(heat → HEX → energy)

II.p converting means is a means to use the product of compression as a propellant (product → propellant → energy)

II.q converting means is a means to use the product of compression to heat a substance that is used to transform the transferred heat into energy
(product → HEX → substance → HEX → energy)

II.r converting means is a means to use the product in a mixture to generate energy (product → mixture → energy)

Currently, Claim 17 and 40 are generic.

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4. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Kevin Mun whose telephone number is 703-305-1839. The examiner can normally be reached on Tue-Fri 8:00-5:30.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

K. Kevin Mun
March 31, 2000


Charles T. Jordan
Supervisory Patent Examiner
Group 3600